

## **REMARKS**

Claims 22-40 and 42-69 are pending in the Application and all stand rejected in the Office action mailed January 5, 2010. No claims are substantively amended by this response<sup>1</sup>. Claims 22, 47, and 60 are independent claims. Claims 23-40 and 42-46, 48-59, and 61-69 depend, respectively, from independent claims 22, 47, and 60. Applicants respectfully request reconsideration of claims 22-40 and 42-69, in view of the following remarks.

As an initial matter, Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth “all reasons and bases” for rejecting the claims.

Applicants respectfully request withdrawal of the finality of the Office action mailed January 5, 2010, for at least the reasons set forth below.

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<sup>1</sup> No claims are substantively amended. Claims 22, 47, and 60 are amended to correct a noted minor grammatical error. Applicants respectfully submit that these amendments do not alter the scope of the claims or add new matter.

### **Amendments to the Specification**

Applicants have amended the Specification as shown above to update information about related applications. Applicants respectfully submit that these amendments do not add new matter.

### **Amendments to the Claims**

Claims 22, 47, and 60 have been amended to correct a noted minor grammatical error. Applicants respectfully submit that the amendment to each of claims 22, 47, and 60 does not add new matter, nor does it change claim scope.

### **Rejections of Claims**

Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, and 65-69 were rejected under 35 U.S.C. §102(e) as being anticipated by Baum, *et al.* (US 5,761,281, hereinafter "Baum"). Claims 23-25, 29-33, 44, 48-51, 56, and 61-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Henley, *et al.* (US 5,526,353, hereinafter "Henley"). Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum and Henley, in view of Lev, *et al.* (US 5,729,544, hereinafter "Lev"). Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Barak (US 5,764,741). Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Fleischer, III *et al.* (US 5,592,541, hereinafter "Fleischer, III"). Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Sharman (US 5,774,854). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those set forth below.

**I. Baum Does Not Anticipate Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, And 65-69**

Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, and 65-69 were rejected under 35 U.S.C. §102(e) as being anticipated by Baum. Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Further, “[t]he elements **must be arranged as required by the claim**, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” MPEP § 2131 (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); emphasis added).

Applicants respectfully submit that the teachings of Baum are being misinterpreted, and that Baum does not teach each and every element of independent claims 22, 47, and 60, or any claims that depend therefrom.

Applicants respectfully submit that Baum relates to transmission of data, not voice, over voice band circuits of a telephone company network to a “network access server.” See Abstract and Fig. 1. Call originators are linked via modem to telephone lines in the form of analog modem signals. See *id.* at col. 7, lines 38 to col. 8, line 2. The analog modem signals are digitized by the telephone company network and placed into individual DS0 channels of a T1 span, and fed into the “network access server.” See *id.* at col. 8, lines 2-14. Each DS0 carries a digital representation of one analog voice channel carrying a modem signal from a call originator. The modem signals are received by the “network access server,” the “network access server” uses appropriate protocol parameters associated with control signals from the incoming call to configure itself, and the data received from the call originator is transmitted over a network. See *id.* at col. 8, lines 42-60.

**With regard to independent claim 22**, Applicants respectfully submit that claim 22 now recites, in part, “[a] communication system controller comprising: ... wherein the parameters for configuring the information transmission device comprise information related to the conversion of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information.” Applicants respectfully submit that the Baum does not teach, suggest, or disclose at least this aspect of Applicants’ claim 22. Applicants respectfully submit that claims 47 and 60 recite similar features.

The Office rejects this aspect of Applicants’ claim 22 stating, at pages 2-3:

**Regarding claim 22**, Baum et al. disclose a communication system controller comprising: ... wherein the parameters for configuring the information transmission device comprise information related to the conversion of digitized voice information into an analog voice signal, and an analog voice signal into digitized voice information (**see Fig. 1; modem inside network server is configured with configuration parameter (claim 1) to support conversion between digital and analog as shown in Fig. 1)(data as taught by Baum before being placed on the T1 line is in analog from [sic] and transmitted on the telephone lines 40, 42, and 44. The calls from the call originators are then converted to digital signals (calls are digitized) and placed into the T1 line (see col. 8, lines 1-8))((call signaling is for voice service (col. 19 lines 30-31) and the signaling bits (for T1 DS0) translate directly into E and M signaling (signaling for voice service) (col. 19 lines 65-66);**

(emphasis in original)

The Office again asserts that the “modem inside network server is configured with configuration parameter (claim 1) to support conversion between digital and analog as shown in Fig. 1.” Initially, Applicants respectfully submit that claim 1 of Baum fails to teach, suggest, or even mention “configuration parameters” to “support conversion between digital and analog,” and that claim 1 is silent with respect to a “modem”, or of “conversion” of any sort, let alone “conversion between digital and analog,” as asserted by the Office. Fig. 1 also fails to show “configuration parameters,” let alone configuring

a “modem” in the “network access server 30” with “configuration parameters” to support “analog to digital” / “digital to analog” conversion, contrary to the assertion by the Office.

In addition, Applicants respectfully submit that that the cited portions of Baum at col. 8, lines 1-8, col. 19, lines 30-31, and col. 19, lines 65-66 do not teach, suggest, or disclose the configuration of the “modem inside network [access] server [30]” to “support conversion between digital and analog.” Applicants respectfully note that the only explicit identification by the Office of any teaching of conversion between digital and analog is located in the “telephone company network 50” of Fig. 1. *See id.* at col. 8, lines 1-8.

Applicants respectfully submit that neither the cited portions, nor any other text or figure of Baum teaches or suggests that any alleged configuration of the “modem inside network [access] server [30]” provides any support for digital to analog/analog to digital conversion by the “telephone company network 50.” Further, the Office has not provided any explanation of how and why configuration of a modem in the “network access server 30,” which is separate from and remotely connected to the “telephone company network 50” by a digital “T1 span 51,” provides support of any kind for the “digital to analog” / “analog to digital” conversion performed by the “telephone company network 50,” of Fig. 1. **Applicants respectfully request that the Office specifically explain the nature of the asserted teaching of support in any future Office action, should the rejection be maintained.** In any event, Applicants’ claim 22 does not recite “support” as asserted by the Office. Instead, Applicants’ claim 22 requires, in part, “wherein the parameters for configuring the information transmission device comprise information related to the conversion of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information.” Applicants respectfully submit that Baum fails to teach at least this aspect of claim 22.

In addition, to the extent that the Office may be asserting that the “modem inside network server 30” performs “digital to analog” / “analog to digital” conversion, and that Baum teaches configuration of the “modem inside network [access] server [30]” to support such conversion, Applicants respectfully disagree. Applicants respectfully submit that Baum does not teach, suggest, or disclose that the “modem modules 76a,

76b, etc.” perform “analog to digital” / “digital to analog conversion.” The Office has not identified any portion of Baum that sets forth such a teaching. To the extent that the Office may be asserting that “analog to digital” / “digital to analog” conversion is inherent in a “modem” such as “modems 76a, 76b, etc.” of Baum, Applicants respectfully disagree, and submit that the Office has not met the requirements for an assertion of inherency. The M.P.E.P. sets forth the following:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

See M.P.E.P. §2112(IV).

Applicants respectfully submit that it is not true that a modem must necessarily perform “digital to analog” or “analog to digital” conversion. Applicants respectfully note that the “network access server 30” of Baum receives digital data representing an “analog voice channel” via each DS0 of the “T1 span 51.” *See id.* at col. 8, lines 1-14. The “analog voice channels” provided by the “telephone company network 50” for “telephone lines 40, 42, 44” that carry the “modem signals” produced by a modems “M1,” “M2,” and “M3” are digitized by the “telephony company network 50” before being transmitted on the digital “T1 span 51” to the “network access server 30.” *Id.* “Network access server 30” receives digital data for each “DS0” containing data that represents the “modem signals.” It is well known to those of ordinary skill in the relevant art that such digitized “modem signals” may be processed to arrive at the data originally transmitted by the modems “M1,” “M2,” and “M3” as an analog modem signal. Conversion between analog and digital forms is not required. Applicants respectfully submit, therefore, that it is not necessarily true that the “modems 76a, 76b, etc.” of the “network access server 30” must perform “digital to analog” / “analog to digital” conversion.

Applicants also respectfully submit that, to whatever extent the Office may be making such an assertion, the Office has not shown where and how Baum teaches that any configuration of “modems 76a, 76b, etc.,” which Baum does not disclose as

supporting either “analog voice signals” or “digital voice information,” would somehow teach support of “analog to digital” / “digital to analog” conversion by the “telephone company network 50,” as suggested by the Office. Because Baum does not teach that “modems 76a, 76b, etc.” process “analog voice signals” or “digital voice information,” as claimed, there is no support for a teaching of configuring the “modems 76a, 76b, etc.” as required by claim 22.

In addition, Applicants respectfully note that the use of the term “analog voice channel” and “voice service” in Baum does not inherently mean that the signals being carried are, in fact, voice signals. Applicants respectfully submit that the use of the term “voice” in the phrases “analog voice channel” and “voice service” are used to refer to the range of frequencies supported by the “channel” or “service”, but does not define the content of the “channel” or “service.” Indeed, Baum makes it quite clear that the signals carried by the “DS0 channels” of the “T1 span 51” of Fig. 1 are “modem signals.” *See id.* at col. 7, line 38 to col. 8, line 60. The Office is mistaken in its assertion that the teaching of Baum regarding “E and M signaling” somehow teaches that the signals being communicated are necessarily “voice” and therefore disclose Applicants’ “analog voice signal.” *See* Office action at page 3. Applicants respectfully disagree with such an assertion. Applicants respectfully submit that the phrases “analog voice channel” and “voice service” are not defined by Baum as inherently “analog voice signals,” as claimed. Applicants respectfully submit that those of ordinary skill in the relevant art know that “supervisory tones,” “dual-tone multi-frequency (DTMF) signals,” “analog modem signals,” and “fax signals” are all carried by “analog voice channels” and “voice service” lines. Indeed, any signal within the bandwidth supported by the “analog voice channel” or “voice service” line can be carried by those transport means.

Further, Baum teaches that “E and M signaling” is “for an analog voice service from the telephone company’s equipment,” which is shown in Fig. 1 as the “telephone lines 40, 42, and 44,” and that “T1 equipment (i.e., DS1 level service [“T1 Span 51”]) does not use separate signaling leads [“E and M signaling”] to handle call signaling, but instead uses in-band signaling.” *See id.* at col. 91, lines 25-55. As Applicants have shown above, the use of “voice service” is applicable to carry signals other than “analog voice signals,” including “modem signals,” “fax signals,” “DTMF,” and other “in-[voice]-

band” signals. All of these are “voice band signals,” but not all are an “analog voice signal,” as claimed. Therefore, the mere teaching of “E and M signaling,” or an “analog voice channel,” or “voice service” is not an inherent teaching of an “analog voice signal.”

Applicants again respectfully submit, as noted above, that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference**,” and that to anticipate, “[t]he **identical** invention must be shown in as complete detail as is contained in ... the claim.” Further, “[t]he elements **must be arranged as required by the claim**....” Applicants respectfully submit that Baum does not teach each and every element of Applicants’ claim 22 in as complete detail as contained in claim 22, and as arranged as required by claim 22. Therefore, Applicants respectfully submit that the Office has not met the requirements of M.P.E.P. §2131, that Baum does not anticipate claim 22, and that claim 22 is allowable over Baum.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Baum does not teach, suggest, or disclose, at least, “[a] communication system controller comprising: ... wherein the parameters for configuring the information transmission device comprise information related to the conversion of digitized voice information into an analog voice signal, and an analog voice signal into digitized voice information,” as claimed, and that claim 22 is allowable over Baum for at least these reasons, in addition to those presented in prior responses that are hereby incorporated herein as though set forth in full.

**With regard to claim 45**, Applicants respectfully submit that Baum does not teach or suggest, “wherein the interface circuitry is capable of communicating digitized voice information with the information transmission device.” In rejecting claim 45, the Office states, at page 5:

**Regarding claim 45**, Baum et al. further teach wherein the interface circuitry is capable of exchanging digitized voice information with the information transmission device **(see col. 5 lines 54-55; digital data exchanged between the modem and the network application module ; also see col. 8 lines 5-9; calls (voice) from the call**



**originator are digitized (digital data) and fed into the network server 30).**

(emphasis in original)

As previously discussed above with respect to claim 22, Baum does not teach, suggest, or disclose that the “modems 76a, 76b, etc.” communicate “digitized voice information.” Applicants respectfully maintain that the “calls” received by the “modems 76a, 76b, etc.” of Baum are data calls that communicate “modem signals” that are different from “analog voice signals” or “digitized voice information,” as claimed. Therefore, Applicants respectfully submit that the “digital data” allegedly exchanged between the “modem” and the “network application module” (which the Office has identified as teachings Applicants’ claimed “information transmission device” and “interface circuitry,” respectively) is neither “analog voice signals” nor “digitized voice information.” **Applicants respectfully submit that claim 45 is allowable over Baum for at least the reasons set forth above, and request that the Office specifically address the substance of Applicants’ arguments, should the rejection of claim 45 be maintained.**

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Baum does not teach, suggest, or disclose each and every element of Applicants’ claims 22 and 45, as required by M.P.E.P. §2131, that the Office has not established a *prima facie* case of anticipation with respect to claim 22 or any claims that depend therefrom, and that claims 22 and its dependent claims are allowable over the cited art. Further, Applicants have shown that claim 45 is independently allowable over the cited art. Accordingly, Applicants respectfully request that the rejection of claims 22, 27, 28, 34, 37-41, 43, 45, and 46 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

**With regard to independent claims 47 and 60,** Applicants respectfully submit that claims 47 and 60 recite features similar to those of claim 22, and are allowable over the cited art for at least some of the same reasons set forth above and during prior prosecution with respect to claim 22. Accordingly, Applicants respectfully submit that

claims 47 and 60, and their depend claims, are allowable over the cited art for many of the reasons set forth above.

**With regard to claim 67**, Applicants respectfully submit that claim 67 recites, in part, “prompting the user for routing information, if routing information corresponding to the destination address is not available.” The Office cites Baum at col. 21, lines 54-60 as teaching this aspect of claim 67. The cited portion of Baum states the following:

Computer C1 of call originator 20 provides call set-up information, including the telephone 55 number assigned to computer C5, and transmits digital data signals representing digital data to modem M1. Assume that computer C5 is available on number 950-XXXX Modem M1 converts the set-up information and digital data to analog telephone signals on line 40.

Applicants respectfully submit that the cited portion of Baum shown above fails to teach, suggest, or disclose prompting a user, as claimed. Instead, the cited portion of Baum teaches that “computer C1” provides “call set-up information,” which is different from and does not teach **prompting a user** “if routing information corresponding to the destination address is not available,” as required by claim 67. Thus, Applicants believe that claim 67 is independently allowable over Baum, and request reconsideration and withdrawal of the rejection of claim 67.

For at least the reasons set forth above, Applicants respectfully request that the rejection of claims 47, 52-55, 57-60, and 65-69 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

## **II. The Proposed Combination Of Baum And Henley Does Not Render Claims 23-25, 29-33, 44, 48-51, 56, And 61-63 Unpatentable**

Claims 23-25, 29-33, 44, 48-51, 56, and 61-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Henley. Applicants respectfully submit that claims 23-25, 29-33, and 44, claims 48-51 and 56, and claims 61-63 depend, respectively, from independent claims 22, 47, and 60. Applicants respectfully submit that claims 22, 47, and 60 are allowable over the cited art, in that the Office does not assert

that Henley remedies any of the shortcomings of Baum, set forth above. Because independent claims 22, 47, and 60 are allowable over the cited art, Applicants respectfully submit that claims 23-25, 29-33, 44, 48-51, 56, and 61-63 that depend therefrom are also allowable, for at least the same reasons.

Accordingly, Applicants respectfully request that the rejections of claims 23-25, 29-33, 44, 48-51, 56, and 61-63 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **III. The Proposed Combination Of Baum, Henley And Lev Does Not Render Claims 26 And 64 Unpatentable**

Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum and Henley, in view of Lev. Applicants respectfully submit that claims 26 and 64 depend, respectively, from claims 22 and 60. Applicants respectfully submit that claims 22 and 60 are allowable over the cited art, in that the Office does not assert that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claims 22 and 60 are allowable over the cited art, Applicants respectfully submit that claims 26 and 64 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 26 and 64 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **IV. The Proposed Combination Of Baum And Barak Does Not Render Claim 35 Unpatentable**

Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Barak. Applicants respectfully submit that claim 35 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 35 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 35 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**V. The Proposed Combination Of Baum And Fleischer, III Does Not Render Claim 36 Unpatentable**

Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Fleischer, III. Applicants respectfully submit that claim 36 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 36 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 36 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**VI. The Proposed Combination Of Baum And Sharman Does Not Render Claim 42 Unpatentable**

Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Sharman. Applicants respectfully submit that claim 42 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 42 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 42 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

## Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicants believe that all of pending claims 22-40 and 42-69 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: March 5, 2010

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